

REMARKS**Overview**

Claims 1-21 are pending in this application. The present response is intended to traverse all rejections. The present response is an earnest effort to secure immediate allowance of the claims.

Issues Under 35 U.S.C. § 103

Claims 1-6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U. S. Patent No. 5,721,783 to Anderson in view of U. S. Patent No. 6,048,305 to Bauman. These rejections are respectfully traversed.

Anderson is directed towards a hearing aid with a wireless remote processor (Abstract). Bauman is directed towards an open-in-the-ear auditory pathway stimulator device that includes a noise generator (Abstract). The device of Bauman can also include a hearing aid (Abstract). When Bauman and Anderson are considered in their proper context, it is respectfully submitted there is no proper motivation or suggestion to combine these references in the manner suggested by the Examiner. The Examiner's purported motivation or suggestion to combine is that:

"It would have been obvious for one of ordinary skill in the art at the time of the invention to substitute the housing structure in figure 1 or figure 4 of Bauman for the housing structure in figure 1 of Anderson (see Bauman reference, Column 4, lines 56-57 in which Bauman teaches allowing ambient sound into the external auditory canal and avoiding the occlusion effect; also see Column 6, lines 34-36)."
(Office Action, page 3, lines 6-11).

Column 4, lines 56-57 of Bauman discloses: "In many cases the simulator can be combined with a hearing aid circuit to compensate for a hearing loss." Column 6, lines 34-36 discloses: "If the external ear canal is occluded, typically low frequencies are introduced, making the wearer report that their voice sounds like it is in a barrel." The passages of Bauman to which

the Examiner cites merely describe that Bauman is nonocclusive. There is nothing in these passages that would suggest to one skilled in the art to combine Bauman with Anderson. In particular, nothing to suggest to combine Bauman with a bone conduction signal from a bone conduction sensor or "transmitting the sensed bone conduction signal from a transmitter to the personal communications device" or "processing the sensed bone conduction signal at the personal communications device to create a processed audio signal."

If Bauman and Anderson were to be combined, where would the bone conduction sensor of Applicant's invention go? Bauman does not disclose using a bone conduction sensor in its housing. Its housing is configured for its stimulator device. Why would one skilled in the art use a housing configured for a stimulator device unless a stimulator device was included?

What is apparent from the Examiner's combination is that the Examiner is merely focusing on the obviousness of substitutions and differences instead of on the invention as a whole. This is improper. *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 U.S.P.Q. 81, 93 (Fed. Cir. 1986) ("Focusing on the obviousness of substitutions and differences instead of on the invention as a whole is a legally improper way to simplify the difficult determination of obviousness"). Therefore, it is respectfully submitted the Examiner has failed to make a *prima facie* case of obviousness with respect to claims 1-6. Therefore, it is respectfully submitted that these rejections must be withdrawn.

Claims 7-21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U. S. Patent No. 5,721,783 to Anderson in view of U. S. Patent No. 6,048,305 to Bauman and further in view of U. S. Patent No. 5,692,059 to Kruger. First, the Applicant submits that the combination of Anderson and Bauman is improper as the Examiner does not articulate any motivation or suggestion to combine except for the purported motivation or suggestion to

combine set forth in the rejection of claim 1. As previously explained, there is no proper motivation or suggestion to combine Anderson and Bauman articulated by the Examiner and therefore this rejection should be withdrawn on that basis.

The Examiner recognizes that neither Anderson nor Bauman alone, or in combination teach "simultaneously transmitting signals from both an air sensor and a bone conduction sensor" (Office Action, page 4, numbered paragraph 2). Instead, the Examiner attempts to rely upon Kruger to disclose sensing a bone conduction signal and an air conduction signal and transmitting it, citing to column 3, lines 41-46 (Office Action, page 4, numbered paragraph 2).

At column 3, lines 41-46, Kruger discloses:

"This new system simultaneously uses both a bone and tissue vibration sensing transducer to respond to conducted lower speech frequency voice sounds and a band-limited acoustical microphone to detect the weaker airborne higher speech frequency sounds in the ear canal."

This passage of Kruger does not stand for the proposition asserted by the Examiner. Even if Kruger discloses simultaneous sensing of bone conduction signals and air conduction signals, Kruger does not disclose simultaneously transmitting these signals. Nor does Kruger disclose transmitting the sensed air conduction signal and the sensed bone conduction signal from a transmitter located in an earpiece to a personal communications device. As none of the references disclose transmitting the air conduction signal and the bone conduction signal to a personal communications device, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness and therefore this rejection must be withdrawn.

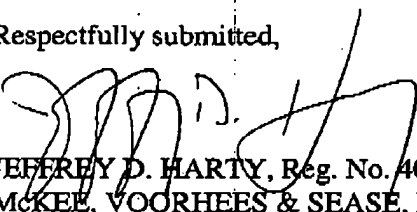
It is further observed that the Examiner appears to be relying upon improper hindsight in making the combination of Kruger with Anderson with Bauman. Although Bauman can be incorporated within a hearing aid, Bauman is directed to a fundamentally different problem than

with Kruger or Anderson as Bauman provides for stimulation. Moreover, Bauman is directed to a fundamentally different problem than Applicant's claimed invention that is directed to communications with an earpiece and not providing stimulation to an ear. The Examiner's apparent selective combination appears to be based on nothing more than hindsight as the Examiner does not point to anything in the prior art as a whole that suggests the desirability of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). Therefore, it is respectfully submitted the Examiner should withdraw the rejections and find claims 7-21 allowable.

This is a request to extend the period for filing a response in the above-identified application for one month from October 23, 2004 to November 23, 2004. Applicant is a small entity; therefore, please charge Deposit Account number 26-0084 the amount of \$55.00 to cover the cost of the one month extension. Any deficiency or overpayment should be charged or credited to Deposit Account 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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